



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,874	06/28/2006	Chad J. Carter	59402US004	1770
33692 7590 03/17/2010 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER DESANTO, MATTHEW F				
ART UNIT 3763		PAPER NUMBER		
NOTIFICATION DATE 03/17/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

LegalDocketing@mmm.com

Office Action Summary

Application No.

10/596,874

Applicant(s)

CARTER, CHAD J.

Examiner

MATTHEW F. DESANTO

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenthal (USPN 3,221,739).
3. Rosenthal discloses a medical device (10), comprising an array comprising microstructures (22) configured to penetrate a membrane upon impact; a connection member affixed to the array in a one piece construction, the connection member (78g) configured to reversibly connect the medical device to an applicator and wherein the connection members are on a collar (30f) and have at least 3 legs for connecting the device to an applicator (figure 19-23).
4. Rosenthal also discloses a kit with multiple needle arrays being sealed in multiple compartments (figure 12 and 13).
5. Claims 1-13, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg (USPN 6,623,457).

6. Rosenberg discloses a medical device, comprising an array comprising microstructures (24) configured to penetrate a membrane upon impact; a connection (16) member affixed to the array in a one piece construction, the connection member (38) configured to reversibly connect the medical device to an applicator and wherein the connection members are on a collar (20) and have at least 3 legs (38) for connecting the device to an applicator (see figure 1 and 3).
7. Rosenberg also discloses a kit with a tray (44) [see figure 1 and 3].

Response to Arguments

8. Applicant's arguments filed 01/04/2010 have been fully considered but they are not persuasive.
9. The examiner respectfully disagrees with the interpretation of the prior art and the claimed invention. With regards to Rosenthal the applicant's representative argues that the prior art cannot penetrate the stratum corneum upon impact. The examiner disagrees with this interpretation since the needle elements of Rosenthal are intended to pierce the skin and introduce a medicament, which could be the outer layer of the eye (stratum corneum). The claimed invention states "configured to" which the examiner feels that Rosenthal is configured to penetrate the eye since the needle elements can pierce the skin and are capable of being used at the eye location. The applicant also argues the structure of Rosenthal is not a microstructure. The examiner disagrees since no structure is being positively recited as to the dimensions of the needle element in the claimed invention and thus the examiner interprets microneedles to be construed as a

small needle, which is disclosed in the prior art. The examiner would further like to note that no special definition is given in the specification or claims and thus the examiner is giving the broadest reasonable interpretation.

10. With regards to Rosenberg the examiner interprets the device as a one pieced construction when the device is ready to be used and thus forms one piece since all the elements are coupled and attached together. The examiner doesn't interpret the claims to mean monolithic, which it seems like applicant might be arguing. With regards to the interpretation of the prior art, the examiner uses two different reference numbers for the same claimed element is because the connection member is made of several reference numbers in the prior art since the reference numbers disclose a bottom wall, a side wall, and connection element. Therefore the connection member comprises 38+16+18 (as well as other reference numbers in Rosenberg).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto
/Matthew F DeSanto/
Primary Examiner, Art Unit 3763